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June 9, 2004

To: Assistant Commissioner for Patents FAX # (703) 872-9306
Washington, D.C. 20231

Attention: Examiner KIMBERLY S. SMITH
Group Art Unit 3644
Phone Number: (703) 308-8515

Re: **OFFICIAL RESPONSE UNDER 37 CFR §1.111**

The following is an OFFICIAL RESPONSE to an Office Action filed May 19, 2004, in the below-identified U.S. Patent Application.

Application No.	:	**09/700,863**	**Confirmation No. 2839**
Applicant	:	**Philip E. Howse**	
Filed:	:	**November 21, 2000**	
TC/Art Unit:	:	**3644**	
Examiner	:	**Kimberly S. Smith**	
Docket No.	:	**A0-1269**	

Submitted by:
Gary M. Hartman
Reg. No. 33,898

OFFICIAL

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Gary M. Hartman Date: June 9, 2004

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Filed:	:	November 21, 2000	
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Examiner	:	Kimberly S. Smith	
Docket No.	:	A0-1269	
Customer No.	:	27127	

COMMUNICATION UNDER 37 CFR §1.111:
REQUEST FOR WITHDRAWAL OF OUTSTANDING OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Applicant's undersigned representative has reviewed the Office Action dated May 19, 2004 (Paper No. 20040517), in which all of the pending claims were rejected, namely, claims 1, 3, 4, 7-18, 20-23, 25, 26, 28-32, 35-46, 50, 51, 53 and 56.

The "Detailed Action" section of the Office Action did not set forth any prior art rejections, but instead was limited to stating grounds for rejecting the claims under 35 USC §112, first and second paragraphs. Specifically: claims 1, 3, 4, 7-18, 20-23,

25, 26, 28, 32, 35-44, and 53 were rejected under 35 USC §112, first paragraph, as lacking support in the specification as filed; and claims 1, 3, 4, 7-18, 20-23, 25, 26, 28-32, and 35-46, 50, 51, 53 and 56 were rejected under 35 USC §112, second paragraph, as being indefinite.

Though the "Detailed Action" section of the Office Action did not set forth any prior art rejections, previous prior art rejections were described as not being overcome in the "Response to Amendment" section of the Office Action. The explanation for maintaining the prior art rejections did not take into account the claims as pending, including the limitations deemed by the Examiner as being indefinite or lacking support. Such an omission is contrary to MPEP 2173.06, which states that "All words in a claim must be considered in judging the patentability of a claim against the prior art" (citing *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970)). More specific to obviousness rejections, MPEP 2143.03 instructs that "INDEFINITE LIMITATIONS MUST BE CONSIDERED" and "LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED" in order to establish rejections under 35 USC §103. Therefore, the Examiner must establish how the claims *as currently pending* - including *all* of their limitations, whether or not they may be indefinite or lack support - are anticipated or obvious over the prior art.

In view of the above, Applicant respectfully believes that the present Office Action is incomplete, and respectfully requests withdrawal of the present Office Action so that a complete Office Action can be filed in its place.

In view of the instructions found at MPEP 2173.06 regarding the degree of uncertainty of a claim rejected as indefinite, Applicant also wishes to briefly comment on the rejections under 35 USC §112, second paragraph. The paragraph numbers refer to the paragraph numbering in the Office Action.

Paragraph 7:

At the precise moment the particulate matter becomes airborne, the particulate matter is not electrostatically charged because the particulate matter is not electrostatically charged while on the surface supporting it. So, it is not indefinite for claim 10 to recite that "the particulate material is not electrostatically charged when first rendered airborne by the pest."

Paragraph 8:

In response to the Examiner's first question, there are no perfect insulators

and all electrostatically charged bodies eventually lose their charge, e.g., via moisture in the air (see Applicant's specification at page 5, lines 22-23). Therefore, it is not indefinite for claim 11 to recite that "the particulate material is initially deposited in the region of the surface as an electrostatically charged fine powder whose electrostatic charge subsequently discharges."

In response to the Examiner's second question, Applicant notes that claim 11 is a method and therefore Applicant's claimed method requires depositing "the particulate material . . . as an electrostatically charged fine powder" followed by discharging of the electrostatic charge, thereby yielding the non-electrostatically charged particles of claim 10. Therefore, it is not necessary for one to go back in time "to determine that a once charged powder is completely discharged," as alleged by the Examiner. Instead, the method of claim 11 recites a preceding step to claim 10, and this step and its effect can be readily observed and understood by one of ordinary skill in the art.

Paragraph 9:

This basis for indefiniteness can be readily remedied by eliminating the word "further."

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Communication dated June 9, 2004

Paragraph 10:

MPEP 2173.05(b), entitled "Relative Terminology," states:

> The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Unquestionably, the objects of Applicant's invention include a device and method for electrostatically coating a pest with a particulate material (page 2, lines 8-13) while eliminating or substantially reducing undesired removal of the particulate material (page 3, lines 4-6). The relative term "readily dislodged" is used in the phrase "readily dislodged from the region by air flowing at the surface while not being readily dislodged by air flowing across the surface." One of ordinary skill in the art would understand the meaning of the relative term "readily dislodged" based on the above-noted objects of the invention. Any possible lingering uncertainty would be resolved by Applicant's teachings that a "downthrust of air generated by such a pest's wing beats . . . render[s] the particulate material . . . airborne" (page 6, lines 19-24) while "gas . . . directed across the surface" does not remove a significant amount of particulate material (page 13, line 28-page 14, line 3).

Paragraph 11:

Use of the term "sufficient" is permissible if the intended effect is recited in the claim, e.g., "sufficiently readily dislodged from the region" to be dislodged "by forces resulting from wing beats of the pest while adjacent the surface." See *In re Halleck*, 164 USPQ 647 (CCPA 1970); *Ex parte Fredricksen*, 102 USPQ 35 (CCPA 1964); and *Ex parte Story*, 169 USPQ 494 (Board of Appeals, 1971). Therefore, claim 1 provides a basis for ascertaining what is "sufficiently readily dislodged."

Paragraph 12:

In method claim 53, "the particulate material is deposited in the recess as an electrostatically-charged fine powder whose electrostatic charge subsequently discharges" so that (per parent method claim 51) "the particulate material is not electrostatically charged while within the recess so as to be readily dislodged from the recess by air flowing at the surface." Therefore, it would be easily understood by one of ordinary skill that claims 51 and 53 recite a process in which particles, though charged when initially deposited, are not charged when the trap is put in use.

Applicant is foregoing this opportunity to amend the pending claims in order to preserve their scope so that the issues of anticipation and obviousness can be

addressed in the substitute Office Action that Applicant requested above, and hereby again respectfully requests.

Should the Examiner have any questions concerning any matter now of record, Applicant's representative may be reached at (219) 462-4999.

Respectfully submitted,

By _____
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June 9, 2004
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